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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/764,279

01/22/2004

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/764,279	Applicant(s) KUGLEN, FRANCESCA B.	
	Examiner Robyn Doan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The affidavit of Laurie Erickson, Connie Montiece Stewart under 37 CFR 1.132 filed 12/10/09 are insufficient to overcome the rejection of claims 1-35 based upon Kuglen in view of Leslie and Suzuki as set forth in the last Office action.

The declarations are insufficient because it includes statements which amount to an affirmation that the claimed subject matter functions as it was intended to function. This is not relevant to the issue of nonobviousness of the claimed subject matter and provides no objective evidence thereof. See MPEP § 716.

The affidavits of Stan Reyes and Masaaki Suzuki under 37 CFR 1.132 filed 12/10/09 are insufficient to overcome the rejection of claims 1-35 based upon Kuglen in view of Leslie and Suzuki as set forth in the last Office action

The declarations are insufficient because it refers only to the whole device described in the above referenced application (i.e, the wire looped combs with an elastic beaded mesh extending from the combs) and not to the individual claims of the application. As such the declarations do not show that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

The affidavit of Lisa Osbourne Connolly under 37 CFR 1.132 filed 12/10/09 raised a commercialized issue in this application, therefore, a rejection under the 35 U.S.C 102 (b) follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-35 are rejected under 35 U.S.C. 102(b) based upon Lisa Orborne Connolly's declaration.

The declaration by Connolly in col. 9-12 indicated that the complete product of the instant invention is offered to Goody's company for sell and or licensing 1 year prior to the filing date of 4/27/2003, therefore, it constitutes to a commercialized agreement. See MPEP §2133.03 (e) (i).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ruffio (U.S. Pat. # 1,665,380).

With regard to claim 1, Ruffio discloses a hair retainer (fig. 2) comprising two opposed combs (13), each of the combs having a spine (11) defining the width of the comb and parallel comb teeth (at 13) projecting from the spine; a stretchable elastic mesh (10, col. 2, lines 57-58, 71-72, fig. 2) secured between the spines of the combs to

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produce tension between the combs when combs are moved away from each other, the elastic mesh having a width comparable to the width of the combs (Applicant is noted that the ends 10b of the mesh having a substantially width comparable to the width of the comb) and being formed by elastic strands (it is noted that a plurality of elastic strands woven together to form a mesh) being strung between the spines of the combs so as to form stretchable openings (col. 2, line 72 shows the device being formed of coarse mesh, therefore, it shows openings) which inherently can individually be stretched open so that an amount of the wearer's hair is capable to be pulled if desired; with regard to the limitations "the elastic strands are capable of threadedly beaded to provide a decorative elastic mesh", Applicant is noted that the above device is capable to do so, therefore, it meets the claimed language. In regard to claim 6, the elastic mesh being formed by interconnected elastic strands (see fig. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kuglen (USP 6,123,086) in view of JP # 409299131A.

Kuglen discloses a hair comb retainer (fig. 2) comprising two combs (35, 36), each comb having a spine (37) defining the width of the comb, a plurality of elastic strands (13) extending between and secured at spaced intervals along the spines of the combs, the elastic strands being strung between the spines so as to form stretchable openings (see fig. 1) between the elastic strands through which an amounts of the wearer's hair can be pulled. JP '131 discloses a comb (fig. 1) comprising a metal spine and a row of looped wires forming projecting teeth (5). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to substitute the comb of Kuglen with the wire looped comb as taught by JP '131, since a simple substitute of one known element (i.e. comb) for another as an alternative way of securely hold the hair in place. KSR International co. V. Teleflex Inc., 550 U.S.--, 82USPQ2d 1385 (2007).

Claims 26, 29, 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leslie (USP Design # 483,522) in view of Kuglen and JP '131.

In regard to claims 26, 29, 32, 34, 35, Leslie discloses hair retainer (fig. 1) comprising two opposed combs and a plurality of beaded strands connected the two combs together. Leslie fails to show the strands being made of elastic mesh and the comb being looped metal wire comb. Kuglen as discussed above in claim 32 show a

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plurality of elastic strands connected the two combs together and JP '131 discloses a comb (fig. 1) comprising a metal spine and a row of looped wires forming projecting teeth (5). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the elastic material as taught by Kuglen and the looped metal wire comb as taught by JP '131 into the device of Leslie in order to provide the flexibility to the strands as well as the combs. It would also have been an obvious matter of design choice to construct the elastic strands being in a mesh configuration, since such modification would involve a mere change in a design choice of a known component. With regard to limitations of how the beaded elastic mesh being formed, Applicant is noted that such limitations are directed to a process of making the device and since the shown final product as taught by Leslie in view of Kuglen and JP '131 meets the claimed limitations, the intermediate process is not given patentable weight in an article claim. In regard to claim 33, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the strands to form a crisscross pattern, since such modification would involve a change in the shape of the known component.

Claims 1-25, 27, 28, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leslie in view of Kuglen and JP '131 as applied to claim 32 above, and further in view of Lorbiecki.

In regard to claims 1-4, 6, 8-11, 15-17, 20, 22-25, Leslie in view of Kuglen and JP' 131 discloses the essential claimed invention as discussed above except for the

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elastic strands being in a form a mesh with triangular shaped openings. Lorbiecki discloses a hair net (fig. 2) comprising a beaded mesh (fig. 2) comprising connector beads (8) interconnecting filament strands (3, 4) to form a decorative oven mesh (fig. 2). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the device of Leslie in view of Kuglen and JP '131 with the mesh configuration as taught by Lorbiecki in order to not only maintain the hair but further enhance the attractiveness of the device (col. 1, lines 10-14). In regard to claim 7, it would have been an obvious matter of design choice to construct the filament strands being substantially clear, since such a modification would involved a mere change in the matter of design choice. In regard to claims 5, 12-14, 18, 19, 21, 27, 28, 30, 31, It would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the length of the elastic mesh being between about three and one-half to four inches and the width of the combs and elastic mesh being between about three to four inches and the stretchable openings of the elastic mesh being of at least two different sizes, eight strands being secured at spaced intervals along the spines of the opposed combs and interconnected to form the elastic mesh between the combs, intermediate beads on the elastic strands between the connector beads and wherein the number of intermediate beads between each connector beads being substantially the same, since such a modification would have involved a mere change in the size and shape of the known component. A change in size and shape is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732